

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB. 2, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Sherwin-Williams Company,
assignee of The Thompson Minwax Company

Serial No. 75/134,973

Robert E. McDonald for The Sherwin-Williams Company.

Joyce A. Ward, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney)

Before Simms, Seeherman and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

The Sherwin-Williams Company, assignee of The
Thompson-Minwax Company, has appealed from the refusal of
the Trademark Examining Attorney to register THOMPSON'S PRO
SEAL, with the word "Seal" disclaimed, for "waterproofing
preparations for porous materials and as a bond breaking
compound in concrete construction, concentrated
waterproofing compounds for concrete, metal and wood

surfaces; chemical waterproofing chemicals which prevent mold, mildew and wood rot and helps to prevent fading and greying.”¹ Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant’s mark so resembles marks, registered by ProSeal Products, Inc. and Pacer Technology Corporation, that, if used on applicant’s identified goods, would be likely to cause confusion or mistake or to deceive.

ProSeal Products, Inc. owns the following cited registrations:

Mark	Goods	Registration Number
PRO-SEAL	Sealants and sealers for wet or oily, nonporous surfaces; namely, multipurpose commercial and industrial sealant for construction and marine use, and industrial applications on metal building barns, concrete, cured asphalt, cindercrete and sandstone	Reg. No. 1,691,541 ²
PRO-SEAL SP12	Sealant for wet or dry, nonporous surfaces, namely sealant for cement, cured asphalt, cindercrete and sandstone for multipurpose commercial and industrial use	Reg. No. 1,686,418 ³

¹ Application Serial No. 75/134,973. filed July 16, 1996, based on an asserted bona fide intention to use the mark in commerce.

² Issued June 9, 1992; Section 8 affidavit accepted; Section 15 affidavit received.

³ Issued June 22, 1989; Section 8 affidavit accepted.

PRO-SEAL DP-36	Sealant for wet or oily, nonporous surfaces, namely concrete sealant for multipurpose commercial and industrial use	Reg. No. 1,689,036 ⁴
PRO-SEAL 58	Sealant for wet or oily, nonporous surfaces, namely, multipurpose commercial and industrial sealant for construction and marine use, and industrial applications on metal buildings and barns	Reg. No. 1,691,539 ⁵
PRO-SEAL 34	Sealant for wet or oily, nonporous surfaces, namely, multipurpose commercial and industrial sealant for construction and marine use, and industrial applications on metal buildings and barns	Reg. No. 1,691,540 ⁶

Pacer Technology Corporation owns the following cited registrations:

Mark	Goods	Registration Number
(with the word "Seal" disclaimed)	silicone sealant and adhesive for household and automobile use	Reg. No. 1,339,866 ⁷
PRO SEAL (with the word "Seal" disclaimed)	adhesives for general household use, thread locking compositions for automotive and general household use, adhesives	Reg. No. 1,525,032 ⁸

⁴, Issued June 22, 1989; Section 8 affidavit accepted.

⁵, Issued June 9, 1992; Section 8 affidavit accepted.

⁶, Issued June 9, 1992; Section 8 affidavit accepted.

⁷, Issued June 11, 1985; Section 8 affidavit accepted; Section 15 affidavit received.

⁸ Issued February 21, 1989. Section 8 affidavit accepted; Section 15 affidavit received.

	for bonding rear view mirror brackets to windshields, gasket removing solvent composition, and disc brake silencer composition in Class 1; gasket shellac compound in Class 2; and sealant and gasket compounds for automotive and general household use, and metal-filled putty for repairing gas tanks" in Class 17	
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The appeal has been fully briefed, but an oral hearing was not requested.

We reverse the refusals of registration.

Turning first to the registrations owned by Pacer Technology Corporation, the record does not establish that the goods identified in those registrations are sufficiently related to the goods identified in applicant's application to support a finding of likelihood of confusion. In this connection, we note that the Examining Attorney has not submitted any evidence regarding such goods, the conditions surrounding their marketing, or the manner in which they may be encountered by customers. The Examining Attorney states only that all of the goods are "sealants." However, the mere fact that a single term can be found to describe all the products is not a sufficient

basis on which to find likelihood of confusion. See **In re Cotter and Company**, 179 USPQ 828 (TTAB 1973). A silicone sealant for household and automobile use such as that identified in Registration No. 1,339,866 is a different product, and has a different purpose, from the waterproofing preparations for porous materials, bond breaking compound in concrete construction, etc. that is identified in the application. As for the goods in Registration No. 1,525,032, the Examining Attorney has not specified which of the three classes of goods in that registration to which the refusal pertains, so we must assume that it was made with respect to all three. Of those goods, the adhesives identified in Class 1 and the gasket shellac compound in Class 2 are clearly different from applicant's identified goods. The only goods that seem even remotely similar are the "sealant and gasket compounds for automotive and general household use" in Class 17. However, as noted above, the fact that one may be able to use the same general term to describe various goods does not necessarily make those goods the same. The sealant and gasket compounds described in the cited registration are designed to prevent leaks by forming a gasket or seal, while products identified in the

application are waterproofing products which are applied to material to protect it.

As applicant has pointed out, the word "SEAL" is descriptive of the registrants' goods, and the term "PRO" is an abbreviation of the laudatory term "professional."⁹ Thus, each of the cited marks is highly suggestive, and is not entitled to a wide scope of protection. In view of the weakness of the marks, and the differences in the goods, we find that there is no likelihood of confusion between applicant's mark and the cited registrations owned by Pacer Technology, Inc.

With respect to the registrations owned by ProSeal Products, Inc., the identifications show that they are commercial and industrial sealants. These goods could be commercially related to applicant's waterproofing compounds, at least to the extent that they are intended to protect concrete. However, the only area of overlap of customers for applicant's and this registrant's goods would be those who purchase sealants for commercial and

⁹ The Random House Dictionary of the English Language, 2d ed., unabridged, © 1987. The Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

industrial use.¹⁰ Such purchasers, however, must be considered to be more knowledgeable than the general public, and to exercise greater care in the selection of goods. As a result, they will recognize, and give weight to, the inclusion of the term THOMPSON'S in applicant's mark. In that connection, applicant has asserted that the THOMPSON'S mark has been used extensively on related products, and has been registered for goods virtually identical to those in the present application. See Registration No. 1,124,802.

The Examining Attorney points out the general rule that one may not add a house mark to one of two otherwise confusingly similar marks and thereby avoid confusion. There are exceptions to this rule, however, when there are some recognizable differences between the assertedly conflicting product marks, or when the product mark is merely descriptive. See **In re C. F. Hathaway Co.**, 190 USPQ 343 (TTAB 1976). In this case, the registered mark PRO-SEAL is so highly suggestive of the goods that the knowledgeable consumers of applicant's and registrant's products will realize that THOMPSON'S PRO SEAL and PRO-SEAL

¹⁰ We note applicant's assertion that its goods are typically bought by "do-it-yourself" customers, but because its identification is not so limited, we must assume that the goods are purchased by the same commercial and industrial users which would purchase the registrant's goods.

identify goods coming from different sources. The additional differences created by the "model numbers" in ProSeal's other marks only enhance this distinction.

Accordingly, in view of the highly suggestive nature of ProSeal's marks and the discriminating purchasers for the goods, we find that when the marks are compared in their entireties the differences between applicant's mark and the cited marks are sufficient to avoid confusion.

Decision: The refusal of registration is reversed.

R. L. Simms

E. J. Seeherman

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board